

ESTTA Tracking number: **ESTTA437409**

Filing date: **10/24/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Urban Home		
Entity	Corporation	Citizenship	California
Address	3301 Sturgis Road, Suite 101 Oxnard, CA 93030 UNITED STATES		

Attorney information	Daniel M. Cislo, Esq. Cislo & Thomas LLP 1333 2nd Street, Suite 500 Santa Monica, CA 90401-4110 UNITED STATES ttab@cislo.com, sguina@cislo.com, kristin@cislo.com Phone:3104510647
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### Registration Subject to Cancellation

Registration No	3187905	Registration date	12/19/2006
Registrant	MAAX CANADA, INC. 160 St-Joseph boulevard Lachine, PQ H8S 2L3 CANADA		

### Goods/Services Subject to Cancellation

Class 011. First Use: 2004/03/23 First Use In Commerce: 2004/03/23 All goods and services in the class are cancelled, namely: Bathtubs, showers and shower-baths either with or without built-in water jets, air jets and/or steam features
Class 020. First Use: 2004/03/23 First Use In Commerce: 2004/03/23 All goods and services in the class are cancelled, namely: Glass-fronted aluminum bathroom cabinets with hallogen light

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85319550	Application Date	05/12/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	URBAN HOME		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 020. First use: First Use: 2000/12/01 First Use In Commerce: 2000/12/01 Furniture, home furnishings, furniture sales, and sales of home furnishings by way of a retail outlet or outlets

Attachments	85319550#TMSN.jpeg ( 1 page )( bytes ) PETITIONFINAL.pdf ( 6 pages )(616996 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Daniel M Cislo/
Name	Daniel M. Cislo, Esq.
Date	10/24/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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**IN THE MATTER OF TRADEMARK REGISTRATION NO. 3,187,905  
REGISTERED ON DECEMBER 19, 2006**

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URBAN HOME, a California corporation,	)	<b>CANCELLATION NO.</b>
	)	
PETITIONER,	)	
vs.	)	
	)	<b>PETITION FOR CANCELLATION</b>
MAAX CANADA, INC. a Canada corporation,	)	
	)	
REGISTRANT.	)	
	)	
	)	
	)	

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Petitioner, URBAN HOME, a California corporation, having offices at 3301 Sturgis Road, Suite 101, Oxnard, California 93030 (“Urban Home”), hereby petitions to cancel Registration No. 3,187,905 for URBAN, registered on the Principal Register on December 19, 2006 by Registrant, MAAX CANADA, INC. a Canada corporation, having a listed business address of 160 St. Joseph Blvd., Lachine, PQ H8S 2L3 CANADA. According to the U.S. Trademark Assignment Abstract of Title available from the [www.uspto.gov](http://www.uspto.gov), it appears that Maax Canada, Inc. assigned the entire interest in and to the mark on September 18, 2008 to Maax U.S. Corp, a Delaware corporation, having a listed business address of Brookfield Place, 181 Bay Street, Ste. 300, Toronto, Ontario, Canada M5J 2T3 and a correspondent listed as Caroline Geiger, Weil, Gotshal & Manges, 767 5<sup>th</sup> Ave New York, NY 10153

The grounds for cancellation are as follows:

1. Registrant is the listed owner of the above-identified trademark registration for “URBAN” (“Registrant’s Mark”), which was registered on the Principal Register on December 19, 2006 and covers “bathtubs, showers, and shower-baths either with or without built-in water jets, air jets, and/or steam features” in International Class 011 and “glass-fronted aluminum bathroom cabinets with halogen light” in International Class 020 (hereinafter “Registrant’s Goods”), based upon a first use in commerce and a first use as early as March 23, 2004.

2. Since as early as December 2000, Petitioner has continuously used the terms “URBAN HOME” (“Petitioner’s Mark”) in interstate commerce for furniture, home furnishings, furniture sales, and sales of home furnishings by way of a retail outlet or outlets (“Petitioner’s Goods”). Petitioner’s Mark has also continuously appeared in substantial advertising and promotion of Petitioner’s Goods, such that the Mark is closely identified with Petitioner’s Goods and has gained very valuable public recognition. Petitioner has established an outstanding reputation as to the quality of its products sold under the URBAN HOME mark.

3. Petitioner has continuously used its Mark in interstate commerce since long prior to any date upon which Registrant can rely. By virtue of its sales of high-quality products bearing Petitioner’s Mark in interstate commerce, its expenditures of considerable sums for promotional activities and the excellence of its products, Petitioner has developed significant goodwill in its Mark and a valuable reputation.

4. Petitioner's trademark rights for the URBAN HOME (U.S. Trademark Application Serial No. 85/319,550) has priority over Registrant's Mark, inasmuch as Petitioner has continuously used its Mark since it commenced use on or about December 1, 2000.

5. Registrant's Mark so resembles Petitioner's Mark that has been and is currently used, as to be likely to cause confusion, or cause mistake, or to deceive, in violation of Section 2(d) of The Trademark Act, 15 U.S.C. §1052(d), when used on or in connection with Registrant's Goods.

6. Under the circumstances, continued registration of Registrant's Mark will injure Petitioner by causing the trade and/or purchasing public to be confused, and/or deceived into believing that Registrant's Goods are those of Petitioner, or are sponsored by Petitioner, to Petitioner's damage and will place a cloud over Petitioner's title to its URBAN HOME mark, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d).

7. Continued registration of Registrant's Mark would diminish the advertising value in Petitioner's URBAN HOME mark, and such registration would, in the event of quality problems involving the goods offered by Registrant under its Mark, tarnish Petitioner's Mark, as well as lessen the capacity of Petitioner's mark to identify and distinguish Petitioner's Goods.

8. Registrant's Mark is the same as, or substantially the same as, Petitioner's URBAN HOME mark, including in visual appearance and pronunciation.

9. Registrant's Mark is likely to and/or has diluted and lessened the capacity of Petitioner's URBAN HOME mark to identify and distinguish Petitioner's goods.

10. Registrant's Mark so resembles Petitioner's prior-used URBAN HOME mark as to be likely, when used in connection with Registrant's Goods, to lessen the capacity of Petitioner's Mark to identify and distinguish Petitioner's Goods, regardless of the presence or absence of competition between Petitioner and Registrant, or the likelihood of confusion, mistake or deception.

11. The subject Registration should be cancelled because Petitioner's right of continuing its present use of its URBAN HOME mark in commerce is, or will be, threatened by the subject registration. Such registration would also be inconsistent with the prior established rights of Petitioner in its URBAN HOME mark and is now and will continue to be a source of damage and injury to Petitioner.

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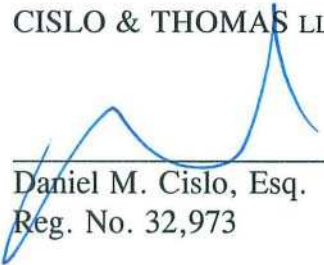
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WHEREFORE Petitioner prays that this Petition for Cancellation be sustained in favor of Petitioner and that U.S. Trademark Registration No. 3,187,905 be cancelled. Petitioner encloses the required filing fee. Should any additional fees be required, the Patent and Trademark Office is authorized to charge Petitioner's attorney's deposit account no. 03-2030.

Respectfully submitted,

CISLO & THOMAS LLP

Dated: October 24, 2011



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Daniel M. Cislo, Esq.  
Reg. No. 32,973

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## ELECTRONIC MAILING CERTIFICATE

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being submitted electronically through the Electronic System for Trademark Trials and Appeal ("ESTTA") on the date shown below.

on 10-24-11  
October 24, 2011  
Daniel M. Cislo, Esq. Date

## CERTIFICATE OF SERVICE

I hereby certify that one (1) copy of this document is being deposited with the United States Postal Service as First Class Mail, postage affixed, in an envelope addressed to:

Maax Canada, Inc. 160 St. Joseph Boulevard Lachine, PQ H8S2I3 Canada	Mark Weinberg, Director MAAX U.S. Corp. Brookfield Place 181 Bay Street, Suite 300 Toronto, Ontario Canada M5J 2T3
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Dated: October 24, 2011

By: Daniel M. Cislo, Esq.

## CERTIFICATE OF SERVICE

I hereby certify that one (1) copy of this document is being deposited with the United States Postal Service as First Class Mail, postage affixed, in an envelope addressed to:

Caroline Geiger, Esq.  
Weil, Gotshal, & Manges  
767 5<sup>th</sup> Avenue  
New York, NY 10153

Dated: October 24, 2011

By: Daniel M. Cislo, Esq.

CISLO & THOMAS LLP  
1333 2nd Street, Suite 500  
Santa Monica, California 90401-4110  
Tel: (310) 451-0647  
Fax: (310) 394-4477  
www.cislo.com

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